

REMARKS

This Amendment is submitted in response to the Office Action dated December 20, 2000. In the Office Action, the Patent Office objected to the drawings for failing to comply with 37 CFR §1.84(p)(5) because the reference sign "23" mentioned in the description on page 10, line 2, is not shown in the drawings. The Patent Office further objected to the drawings as failing to comply with 37 CFR §1.84(p)(4) because reference characters "23" and "13" have both been used to designate a "return receipt postcard" and because reference character "218" has been used to designate both "perforated tear lines" and an "auxiliary label". Still further, the Patent Office rejected Claims 1-15 under 35 U.S.C. §103(a) as being unpatentable over *Petkovsek* (U.S. Patent No. 5,697,648); and the Patent Office rejected Claims 16-20 under 35 U.S.C. §103(a) as being unpatentable over *Walz* (U.S. Patent No. 5,664,725). The Patent Office also stated that Claims 1-15 are not entitled to a date earlier than the actual filing date of this application under MPEP §2133.01 since the patent reference, *Petkovsek*, is considered prior art. The Patent Office stated that *Petkovsek* is considered prior art because *Petkovsek* issued more than one year prior to the actual filing date, May 28, 1999, of the application, and Claims 1-15 of the present application recite subject matter not supported by the parent patent (*Petkovsek*).

By the present Amendment, Applicant amended Figure 10, the specification, and Claims 1, 13 and 16. Applicant submits that the amendments to Figure 10, the specification, claims and the following remarks overcome the objections and rejections as made by the Patent Office and place the application in condition for allowance.

More specifically, Figure 10 was amended to include the new reference character "217" referencing a perforated tear line as shown in red on the attached drawing. The specification was amended to correct a typographical error by replacing the reference character "23" with "13". The specification was further amended by replacing "perforated tear lines 216, 218" with "perforated tear lines 216, 217". Applicant submits that the drawings and specification, as amended, overcome the objections of the Patent Office for failing to comply with 37 CFR §1.84(p)(5) and with 37 CFR §1.84(p)(4). Notice to that effect is requested.

The Patent Office rejected Claims 1-15 under 35 U.S.C. §103(a) as being unpatentable over *Petkovsek* (U.S. Patent No. 5,697,648). To this end, Claims 1 and 13 were amended to overcome the rejections of the Patent Office. The Patent Office also rejected Claims 16-20 under 35 U.S.C. §103(a) as being unpatentable over *Walz* (U.S. Patent No. 5,664,725). To this end,

Claim 16 was amended to overcome the rejections of the Patent Office.

More specifically, Claim 1 was amended to define a special service mailing having a backing sheet, a first mailing form and a second mailing form. The first mailing form is removably attached to the backing sheet by an adhesive. The first mailing form includes a first return postcard that is integrally formed with a first designator section indicative of a special service. The first designator section is completely contained within the first exterior sides that define the first return postcard. The second mailing form is removably attached to the first mailing form, and the second mailing form is removably attached to the backing sheet by an adhesive. Further, the second mailing form includes a second return postcard that is integrally formed with a second designator section indicative of the special service. The second designator section is completely contained within second exterior sides that define the second return postcard.

Claim 13 was amended to define a method for preparing a mailpiece for delivery of the mailpiece by a special service. The method has the steps of providing a backing sheet and providing a first mailing form including a first return postcard. The first return postcard is removably attached to the backing sheet that is integrally formed with a first special service designation section. The first special service designation

section is contained completely within the exterior sides that define the first return postcard. The method further has the steps of providing an area within the return postcard wherein variable information is printed and providing a second mailing form. The second mailing form has a second return postcard removably attached to the backing sheet that is integrally formed with a second special designation section. The second special designation section is completely contained within exterior sides that define the second return postcard. The method further has the steps of providing printing information relating to the special service delivery of the mailpiece on the area within the return postcard, removing the first mailing form from the backing sheet, and attaching the first mailing form to the mailpiece to effect delivery of the mailpiece by the special service.

Further, Claim 16 was amended to define a mailing assembly for preparing a mailpiece for delivery by a special service. The assembly has a first mailing form having a first return postcard and a first anchor portion removably attached to the first return postcard. The first anchor portion has an adhesive on a backside of the first anchor portion, and the first return postcard has no adhesive. The assembly further has a first backing strip received over the adhesive on the backside of the first anchor portion and a second mailing form having a second return postcard and a second anchor portion removably attached to the second

return postcard. The second anchor portion has the adhesive on a backside of the second anchor portion and the second return postcard having no adhesive. Still further, the assembly has a second backing strip received over the adhesive on the backside of the second anchor portion and a first designator section indicative of a special service contained completely within the exterior sides of the first return postcard. The first designator section is integrally formed with the return postcard.

Petkovsek teaches a mailing assembly including a single sheet that provides a label that may be attached to an envelope and a return postcard which may be removably attached to an envelope.

Walz merely defines a multi-part mailing form having two superimposed sheets of material wherein detachable areas of the upper sheet are detached and secured to an item to be mailed, and sections of the sheets are separable from one another. One of the separable sections includes a return postcard.

Nowhere do *Petkovsek* or *Walz* teach a designator section within the exterior sides that define a return postcard wherein the designator section is integrally formed with the return postcard.

The arrangement of the return postcard with the designator section provides at least two forms on a single sheet. This arrangement allows incorporation of what previously required

completion of at least two forms and subsequent attachment of two forms to, for example, a package to be delivered requiring special services for delivery thereof. As a result, use of the mailing assembly of the present invention simplifies and expedites the preparation of such a mailpiece requiring delivery by a special service.

In addition, this method allows the user to forgo using a second assembly for a second designated special service for an item to be mailed requiring delivery by a distinct special service.

The Patent Office provided absolutely no teaching whatsoever as to why one having ordinary skill in the art would modify the prior art that was applied in the Office Action to use the same with information related to the delivery of the article by one or more special services on a single sheet.

It is further submitted that the question under 35 U.S.C. §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements performed their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings

of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F. 2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's claimed invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of the *Petkovsek* and *Walz* patents in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

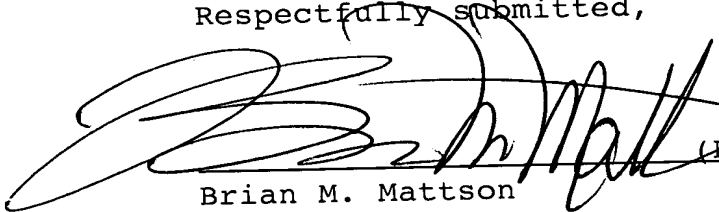
Since the Patent Office failed to establish a *prima facie* case of obviousness, the rejection of the claims under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

Claims 2-12 depend from Claim 1; Claims 14 and 15 depend from Claim 13; and Claims 17-20 depend from Claim 16. These

claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional structural elements and steps of Applicant's invention.

In view of the foregoing, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this **Amendment** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Asst. Commissioner for Patents, Washington, D.C. 20231 on March 19, 2001.



Brian M. Mattson

IN THE SPECIFICATION:

Please replace the first full paragraph on page 10, which may also be identified as the fourth paragraph of the DETAILED DESCRIPTION OF THE PRESENTLY PREFERRED EMBODIMENTS with the following paragraph:

The assembly 10 also has a front bottom portion 18 that includes the return receipt postcard [23] 13 that can be similar to United States Postal Service form PS-3811. The return receipt postcard 13 may include a set of instructions 20 for the sender, as well as an article addressee section 22 for pre-printing the addressee's address. The return receipt postcard 13 also has a document control number bar code 24 to aid in tracking of the article 14.

Please replace the first full paragraph on page 18, which may also be identified as the twenty-sixth paragraph of the DETAILED DESCRIPTION OF THE PRESENTLY PREFERRED EMBODIMENTS with the following paragraph:

Referring now to Figures 10-12, an alternate embodiment of a mailing assembly 200 is generally illustrated. The assembly 200 incorporates a first layer 202 and a second layer 204 with an adhesive 206 in selected areas therebetween as generally illustrated in Figures 11 and 12. The first layer 202 of the

mailing assembly 200 includes a return postcard 208 with an incorporated designator section 210. At each end of the return postcard 208 are anchor portions 212, 214 separable by perforated tear lines 216, [218] 217, respectively. On a back side of each of the anchor portions 212, 214 is the adhesive 206. The adhesive 206 provides for attachment of the first layer 202 to the second layer 204 and following removal of the first layer 202 from the second layer 204, the adhesive 206 beneath the anchor portions 212, 214 allows for attachment of the first layer 202 to a mailpiece. An auxiliary label 218 is provided exterior to the anchor portion 212 and has the adhesive 206 on its back side. As a result, the auxiliary label 218 may be implemented as described with references to Figures 7-9.

IN THE CLAIMS:

Claim 1, as amended, follows:

1. (Amended) A special service mailing assembly comprising:

a backing sheet;

a first mailing form removably attached to the backing sheet by an adhesive wherein the first mailing form includes a first return postcard integrally formed with [and] a first designator section indicative of a special service wherein the first designator section is completely contained within first exterior sides that define the first return postcard; and

a second mailing form removably attached to the first mailing form wherein the second mailing form is removably attached to the backing sheet by the adhesive and further wherein the second mailing form includes a second return postcard integrally formed with [and] a second designator section indicative of the special service wherein the second designator section is completely contained within second exterior sides that define the second return postcard.

Claim 13, as amended, follows:

13. (Amended) A method for preparing a mailpiece for delivery of the mailpiece by a special service, the method comprising the steps of:

providing a backing sheet;

providing a first mailing form including a first return postcard removably attached to the backing sheet wherein the first return postcard [has a] is integrally formed with a first special service designation section wherein the first special designation section is completely within exterior sides that define the first return postcard;

providing an area within the return postcard wherein variable information is printed;

providing a second mailing form including a second return postcard removably attached to the backing sheet wherein the second return postcard [has a] is integrally formed with a second

special designation section wherein the second special designation section is completely within exterior sides that define the second return postcard;

printing information relating to the special service delivery of the mailpiece on the area within the return postcard;

removing the first mailing form from the backing sheet; and

attaching the first mailing form to the mailpiece to effect delivery of the mailpiece by the special service.

Claim 16, as amended, follows:

16. (Amended) A mailing assembly for preparing a mailpiece for delivery by a special service, the assembly comprising:

a first mailing form having a first return postcard and a first anchor portion removably attached to the first return postcard wherein the first anchor portion has an adhesive on a backside of the first anchor portion, and further the first return postcard having no adhesive;

a first backing strip received over the adhesive on the backside of the first anchor portion; a second mailing form having a second return postcard and a second anchor portion removably attached to the second return postcard wherein the second anchor portion has the adhesive on a backside of the second anchor portion, and further the second return postcard having no adhesive;

a second backing strip received over the adhesive on the backside of the second anchor portion;

a first designator section indicative of a special service contained within exterior sides of the first return postcard wherein the first designator section is integrally formed with the return postcard.